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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,280	04/30/2001	Frank Thomas		3073

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/845,280

Applicant(s)

THOMAS, FRANK

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-25 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This Office action is responsive to communication received 04/12/2002 –  
Request for Reconsideration.

Claims 1-25 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 STAND rejected under 35 USC §103(a) as being unpatentable over  
Reach in view of Seisaku et al (JP Patent No. 405329233). Reach shows the invention  
substantially as claimed and includes an alignment means extending along a portion of  
the top surface of the head and continuing along onto the hosel segment. The  
alignment means is in the form of a line that is generally parallel to a plane containing  
the striking face. Reach, however, does not show the line extending onto the shaft  
portion in either a continuous or discontinuous fashion. The Japanese reference to  
Seisaku shows it to be old in the art to include an alignment means in the form of a line-  
shaped piece of tape along the shaft in a direction that is parallel to the face of the  
putter. In both Reach and Seisaku, the intent is to provide a golfer standing at address  
with the ability to more readily align the striking face with a ball and the target. Taken as  
a whole, the references to Reach and Seisaku collectively teach that an alignment  
means such as a line may be placed along a path parallel to the plane of the striking

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face to help a player orient the club at address. It would appear that alignment is facilitated by a line on either a combination of the head and hosel segments of the head or on the shaft itself. Clearly, placing the alignment means on both the head and the shaft merely enhances the alignment effect. The fact that the claims require a continuous or discontinuous line would not appear to patentably distinguish over a combination of Reach and Seisaku, since either design for the line would appear to equally provide an appropriate visual alignment tool which a golfer may use to properly place the putter head with respect to a golf ball at address. In view of the patent to Seisaku and the above reasoning, it would have been obvious to modify the device in the cited reference to Reach by extending the line (c) along the shaft (b), the motivation being to simply enhance the effect of the alignment means. With respect to claim 4, note that Reach teaches that the line (c) may be cast as a groove or simply painted on the surface of the head and hosel.

Claims 5-25 STAND allowable over the prior art references of record.

#### RESPONSE TO ARGUMENTS

In the arguments received 04/12/2002, the applicant contends that neither of the prior art documents to Reach nor Seisaku show an alignment means extending along a surface of the shaft and the head in a plane perpendicular to the longitudinal axis and parallel to the striking face. The applicant notes that Figure 1 of Seisaku may appear to show a separate line on the head of the putter, but further argues that even if the separate line is viewed as a sight line, the separate line is not aligned with the tape (4) that is disposed along the shaft in Seisaku. The applicant contends that there is no

motivation to combine the references such that the tape (4) taught by Seisaku should be placed on the shaft of the Reach device.

In response to these arguments, it would appear that the applicant is attacking the references individually. One cannot show non-obviousness by attacking the prior art references on an individual basis where, as is the case in the rejection outlined above, the rejection is based on a combination of references. See In re Keller, 208 USPQ 871 (CCPA 1981). Moreover, it is recognized that the prior art references may not and cannot be combined in an arbitrary fashion and that there must exist some reason why the skilled artisan would have found it obvious to combine the primary and secondary teachings at the time of the invention. See In re Nomiya, 184 USPQ 607 (CCPA 1975). On the other hand, the patent statutes do not require that a motivation to make the proposed modification be expressly articulated in the references. The test for combining references is what the combination of the disclosures considered as a whole would have reasonably suggested to the ordinarily skilled artisan. See In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). Further, the combined references are to be evaluated by what they would have suggested to one of ordinary skill in the art, rather than by what is specifically disclosed by the references. See In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, viewing the combined disclosures of both Reach and Seisaku would have clearly suggested to one of ordinary skill in the art that an alignment means may be fashioned to extend along a surface of both the shaft and the head. If in fact the applicant acknowledges that the Seisaku device displays a line on the putter head surface along with a tape on the surface of the

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shaft, such an observation would only appear to strengthen the position by the Office set forth in the outstanding rejection of claims 1-5. That is, if one interprets Seisaku as including a line on the putter head along with a tape on the shaft, then the modification of Reach is most obvious, since Reach only lacks an alignment means on the shaft, said means being taught by Seisaku. The fact that the line and tape described by the applicant and appearing in Seisaku are not in alignment with one another is irrelevant, since the claims do not require this limitation. Even if, *in arguendo*, the claims did contain a limitation concerning the alignment of a line on the shaft and a line on the head, such would not distinguish over the combined teaching of reach and Seisaku, which together clearly teach that alignment is facilitated by line-shaped markings on the head and the shaft.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
April 24, 2002